

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte SEFTON JOHN

Appeal No. 2003-0568
Application No. 09/264,531

ON BRIEF

Before WILLIAM F. SMITH, ADAMS and GREEN, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the
examiner's final rejection of claims 1-4, which are all the claims pending in the
application.

Claim 1 is illustrative of the subject matter on appeal and is reproduced
below:

1. A method for treating psoriasis and/or photodamage and/or acne in a
human subject by topically applying to the psoriatic or sundamaged
skin and/or acne of said subject an effective amount of tazarotene and
an effective amount of an alpha hydroxy acid.

The reference relied upon by the examiner is:

Yu et al. (Yu)

5,091,171

Feb. 25, 1992

GROUND OF REJECTION

Claims 1-4 stand rejected under 35 U.S.C. § 103, as being based unpatentable over Yu.

We reverse.

DISCUSSION

According to the examiner (Answer, page 3), Yu “discloses a composition of treating acne, psoriasis or aged skin comprising alpha hydroxyacids, glycolic acid ... and retinoids ... wherein the composition is in the form of a gel.” The examiner recognizes, however, that Yu does not teach the retinoid is tazarotene. Answer, page 4. Nevertheless, the examiner alleges Yu’s disclosure of retinoids “suggest all retinoids are functionally equivalent.” Id. Based on this allegation the examiner concludes (id.), “it would have been obvious to one of ordinary skill in the art to use tazarotene, a retinoid, in the composition disclosed by Y[u] et al. since there is no differentiation between the different retinoids suggesting functional equivalency in the absence of a factual showing to the contrary.”

In response, appellant argues (Brief, page 3):

Retinoids are only disclosed at [c]olumn 12, line 9 as one of hundreds to thousands of ingredients that can be combined with alpha hydroxy acids. There is no disclosure as to why retinoids should be so combined, for what use or what amounts. Moreover, the disclosure is broadly to retinoids not tazarotene. Therefore, it is believed that this reference would not motivate one of ordinary skill in the art to combine a specific retinoid, tazarotene, with an alpha hydroxy acid for treating psoriasis, and/or photodamage and/or acne.

We agree. Prima facie obviousness based on a combination of references requires that the prior art provide “a reason, suggestion, or motivation to lead an

inventor to combine those references.” Pro-Mold and Tool Co. v. Great Lakes Plastics Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996).

[E]vidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved.... The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular.

In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (citations omitted). The suggestion to combine prior art references must come from the cited references, not from the application’s disclosure. See In re Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

On this record the examiner fails to provide any factual evidence that would lead a person of ordinary skill in the art at the time the invention was made to modify the Yu reference by combining tazarotene with alpha hydroxy acid as is required by the claimed invention.

Accordingly, we reverse the rejection of claims 1-4 under 35 U.S.C. § 103, as being based unpatentable over Yu.

OTHER ISSUES

We wish to point out to the examiner that there is no requirement in claims 1-4 that tazarotene and alpha hydroxy acid be part of the same composition. See e.g., claim 4, wherein tazarotene is administered once daily in the evening, and alpha hydroxy acid is administered once or twice daily in the morning or evening. In this regard, it is unclear from the “search notes” section of the file wrapper what exactly the examiner searched for. Nevertheless, upon a brief search of the patent database using the search terms “tazarotene” and

“alpha hydroxy acid” we identified two patents that may be relevant to the claimed invention. Ha et al. (Ha), United States Patent No. 5,997,887; and Bershad, United States Patent No. 6,083,963. According to Bershad (column 1, lines 36-41), “[t]here is presently in use an FDA approved treatment for acne employing tazarotene topical gel that is marketed by Allergan, Inc. under the brand name TazoracTM.” In addition, we note that Ha disclose compositions useful for regulating skin conditions caused by factors such as exposure to sun. Column 4, lines 8-19. In this regard, we note that the composition includes, inter alia, tazarotene (column 27, lines 18-19), and glycolic acid (column 28, line 28).

Therefore, upon return of this application to the examiner we recommend the examiner take a step back to consider the full scope of the claimed invention. Thereafter the examiner should consider the patents identified above and make an appropriate updated search of the prior art. In this regard, we encourage the examiner to document any such search in the appropriate section of the file wrapper. If, as the result this search, the examiner finds that a rejection should be made, the examiner should issue an appropriate Office action setting forth such a rejection, using the proper legal standards and clearly setting forth the facts relied upon in support.

We emphasize that any further communication from the examiner which contains a rejection of the claims should provide appellants with a full and fair opportunity to respond.

REVERSED

William F. Smith)	
Administrative Patent Judge)	
)	
)	BOARD OF PATENT
Donald E. Adams)	
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